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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,766	11/16/1998	JOHN F. BREEDIS	101.931	1189

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EXAMINER

IP, SIKYIN

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 08/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



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09/192766

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 3/17/03 ; 3/21/03
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 3-12 is/are pending in the application
Of the above, claim(s) _____ is/are withdrawn from consideration
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 19
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3, and 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 5-311292 (PTO-1449, abstract and page 5, col. 7, sample No. 13 and 14) or JP 7126779 (PTO-1449, page 2, col. 1).

4. Claims 1, 3-4, and 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06228684 (abstract).

5. Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 04231430 (abstract and Table 2) or JP 05059467 (abstract).

6. Claims 1 and 3-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06179932 (abstract).

7. JP 5311292 disclose(s) the features including the claimed Cu base alloy compositions and Ni/P ratio (see abstract and col. 7, sample No. 13 and 14), and the intended electrical use (see translation page 15, lines 4-5) except for the electrical conductivity.
8. JP 7126779 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 19, Table 2) except for the Ni/P ratio.
9. JP 06228684 disclose(s) the features including the claimed Cu base alloy compositions and electrical connector use (abstract), except for electrical conductivity and the Ni/P ratio.
10. JP 04231430 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 7, Table 2) except for the Ni/P ratio.
11. JP 05059467 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 14, col. 6, from right of Table 2) except for the Ni/P ratio.
12. JP 06179932 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 9, first col. From right of Table 1) except for the Ni/P ratio.

13. With respect to the Ni/P ratio that it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

14. With respect to the electrical conductivity, that the instant copper based alloy composition, intended use, and Ni/P ratio are overlapped by the cited JP 5311292 and JP 06228684 references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. Similar process can reasonably be expected to yield products which inherently possess the same properties. *In re Spade*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), *In re DeBlauwe*, 222 USPQ 191, and *In re Wiegand*, 86 USPQ 155 (CCPA 1950). *In re Best*, 195 USPQ, 430 and MPEP § 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*,

195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)."

15. The instant transitional expression "consisting essentially of" includes the optional alloying elements from the cited references. When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of" applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).

Response to Argument

Applicant's arguments filed April 16, 2001 have been fully considered but they are not persuasive.

In paragraph A, applicants argue that the claimed alloy composition and Ni/P ratio of 5:1 have unexpected result. But, the claimed composition and Ni/P ratio as recited in appealed claim 1 are disclosed by JP 05311292 at col. 5, samples No. 13 and 14.

Applicants argue that JP 05311292 broadly teaches Ni/P ratio from 5:1 to 50:1. But, said reference has disclosed Ni/P ratios in col. 5, samples No. 13 and 14 with Ni/P ratios at 5.4 and 7.4 respectively.

Applicants' argument as set forth in page 6 of the instant brief, last paragraph and first paragraph of page 7 is noted. But, alloy 13 of JP 05311292 reference has shown the claimed Ni/P ratio is not critical and does not provide unexpected properties by itself.

Applicants argue that JP 05311292 does not disclose the intended use. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie, Mahlman*, 88 USPQ 478 (CCPA 1951), *Ex parte Douros* 163 USPQ 667 (POBA), *In re Casey*, 152 USPQ 235 (CCPA 1967), and *In re Craige*, 188 F.2d 505, 89 USPQ 393 (CCPA 1951).

Applicants argue that JP 7-126779, JP 4-231430, JP 6-179932, and JP 6-228684 do not disclose the claimed Ni/P ratio. However, said references have Ni and P contents overlapped the claimed range. Furthermore, selecting a range in a known range by optimization for the best results is within ambit of ordinary skill artisan, see *In re Aller, et al.*, 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 276, 205 USPQ

215, 219 (CCPA 1980). Moreover, as are evident by JP5311292 samples No. 13 and 14 that the claimed Ni/P has no unexpected results. With respect to the intended use argument, the examiner reiterates the response as set forth in the paragraph immediately above.

Applicants argue that JP7-126779 and JP04231430 do not teach or suggest the claimed Cu alloy for electrical connector. The examiner disagrees. Applicants' attention is directed to titles of said references which disclose the Cu based alloy is for multipin connectors and sockets and electroconductive material. In JP7-126779 col. 9, Tables shows 37.2 to 40.1 %IACS and JP04231430 col. 5, the Tables shows 19 to 58 %IACS, which meet the claimed greater than 25 %IACS (see appealed claim 1).

Applicants argue that Cu based alloys of JP7-126779, JP04231430, and JP 06179932 disclose many optional elements. First, the instant transitional expression "consisting essentially of" does not exclude any of those elements since applicants have not shown those elements would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948). Second, the listing of numerous solutions (here elements) to a problem does not make any one solution less obvious. Ex parte Raychem Corp. 17 USPQ 2d 1417, 1424 (BPAI

1990) and *Merck & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (CAFC 1983).

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.


The facsimile phone numbers are (703) 872-9310 (non-final Official Paper only), (703) 872-9311 (after-final Official Paper only), and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of

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your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
August 11, 2003